REMARKS

Claims 25, 34, 36 and 38 have been amended. Claims 1-38 are pending in the application. Reconsideration of the application is requested in view of the amendments and the remarks to follow.

Claims 25, 34, 36 and 38 have been amended to address minor informalities noted during review, however, these amendments are not intended to alter the scope of the claims. No new matter is added by the amendments to the claims.

The amendments to Fig. 7 address minor informalities noted during review and/or to bring the Figs. and specification into mutual conformance. No new matter is added by the amendment to Fig. 7.

Response to Rejection under 35 U.S.C. §101:

The Office Action states (p. 2, item 3) that claims 1-24 are directed to non-statutory subject matter. Applicant disagrees and requests reconsideration in view of the remarks to follow.

The Office Action states (p. 2, item 4) that "[i]ndependent claims 1, 12, 20, the combined limitations of each of said claims (i.e. retrieving content, verifying format, scheduling etc.) can be interpreted as a series of mental and/or manual steps, since the combined limitations can be substantially implemented via mental observation and pen/paper, therefore, said claims are directed toward non-statutory subject matter."

First, such is not an appropriate test for statutory subject matter in the context of presently-applicable law. Second, the characterization of the claims is inaccurate. Third, the interpretation offered in the Office Action is clearly inapposite to the paperless workplace, as evidenced by the USPTO's own actions in elimination of many paper copy repositories and procedures. As such, the strained interpretation offered in the Office Action is inconsistent with modern business practices, as evidenced by the USPTO's own actions.

Applicant notes, with respect to the first point raised above, that an appropriate series of tests for statutory subject matter are provided in the Manual of Patent Examination Procedure, e.g., in Chapter 21.

For example, in MPEP §2106, entitled "Patentable Subject Matter - Computer-Related Inventions", this chapter of the MPEP states, in a subsection II(A), entitled "DETERMINE WHAT APPLICANT HAS INVENTED AND IS SEEKING TO PATENT", that Office Personnel should:

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. **That is, it must produce a "useful, concrete and tangible result."** *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

In the instant application, claims 1, 12 and 20 provide useful, concrete and tangible results such as (claim 1): "displaying the particular content at the specified time, the particular content being displayed by a Web server"; (claim 12): "storing the retrieved content in a central database" and "displaying the retrieved content on the Web page at the particular time"; and (claim 20): "storing the retrieved content in a central database" and "scheduling the retrieved content to be displayed at a particular time, wherein the particular time is based on an attribute associated with the retrieved content".

Further guidance in applying presently-applicable examination procedure is provided in subsection IV, entitled "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101". This subsection states that Office personnel are to:

> A. Consider the Breadth of 35 U.S.C. 101 **Under Controlling Law**
>
> As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). Accordingly, section 101 of title 35, United States Code, provides:
>
> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> In *Chakrabarty*, 447 U.S. at 308-309, 206 USPQ at 197, the court stated:
>
> In choosing such expansive terms as "manufacture" and "composition of matter," modified by the comprehensive "any," Congress plainly contemplated that the patent laws would be given wide scope. The relevant legislative history also supports a broad construction. The Patent Act of 1793, authored by Thomas Jefferson, defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318. The Act embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." V Writings of Thomas Jefferson, at 75-76. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (148 USPQ 459, 462-464) (1966). Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word "art" with "process," but otherwise left Jefferson's language intact. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). [Footnote omitted]

This perspective has been embraced by the Federal Circuit:

> The plain and unambiguous meaning of section 101 is that **any new and useful process**, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, **it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations**.

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556.

Further criteria in application of the relevant statute are found in a subsection 1 entitled "Nonstatutory Subject Matter". This subsection defines what is NOT statutory subject matter, stating that:

> Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

As is evident, the subject matter of claims 1-24 is clearly not within the ambit of what is NOT statutory subject matter. Further guidance in applying presently-applicable legal principles to determine what IS statutory subject matter is found in subsection (b) under this heading, entitled "Statutory Process Claims".

This subsection provides tests in assessing "safe harbors" relevant to such subject matter, stating that:

> **A claim that requires one or more acts to be performed defines a process**. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. **To be statutory, a claimed computer-related process must** either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) **be limited to a practical application within the technological arts** (discussed in ii) below). See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

The claims require one or more acts to be performed. They are thus process claims. To be within the ambit of the "safe harbor" comprising statutory subject material, they would need to "be limited to a practical application within the technological arts". The tests for this aspect of the safe harbor are further explained in subsection ii) thereof, entitled "Computer-Related Processes Limited to a Practical Application in the Technological Arts". This subsection states that:

> There is always some form of physical transformation within a computer because a computer acts on signals and transforms them

during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. **What is determinative is** not how the computer performs the process, but **what the computer does to achieve a practical application**. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036.

A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness. In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). **A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful**. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (in [sic] banc). **For example**, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, **a claimed process for digitally filtering noise employing the mathematical algorithm is statutory**.

Numerous examples follow this subsection.

Applicant notes that claims 1, 12 and 20 clearly comply with such requirements because these claims recite acts providing a concrete, useful, tangible result. For example, claim 1 recites acts including: "displaying" which affirmatively provides the concrete, useful and tangible result of "displaying the particular content at the specified time, the particular content being displayed by a Web server". Claim 12 recites acts including: "displaying", which affirmatively provides the concrete, useful and tangible result of "displaying the retrieved content on the Web page at the particular time". Claim 20 recites acts including: "scheduling", which affirmatively provides the concrete, useful and tangible result of "scheduling the retrieved content to be displayed at a particular time, wherein the particular time is based on an attribute associated with the retrieved content".

With respect to the second point noted above, the portion of the recitation of the claims that is subsumed under the comment "etc." in the Office Action includes, e.g., "retrieving content from a plurality of content providers, wherein the retrieved content is to be displayed in at least one Web page" and "displaying the particular content at the specified time, the particular content being displayed by a Web server" (claim 1) and "retrieving new content from the plurality of content providers that have new content to retrieve", "storing the retrieved content in a central database" and "displaying the retrieved content on the Web page at the particular time" (claim 12) and "identifying a plurality of content providers; identifying a storage location associated with each of the content providers; retrieving a file from each storage location, wherein the file identifies any new content to retrieve from the storage location; if the file identifies new content to

retrieve from the storage location: retrieving the new content; storing the retrieved content in a central database; and scheduling the retrieved content to be displayed at a particular time, wherein the particular time is based on an attribute associated with the retrieved content" (claim 20).

Applicant is unable to comprehend how one might "substantially implement" such affirmatively-recited aspects of the claimed subject matter via the proposed "mental and/or manual steps" or "pen/paper". For example, how would one display information on a Web server using the proposed methods? How would one store information in a database using pen and ink or mental steps? Clarification of the rejection is respectfully requested.

Accordingly, Applicant notes that the rejection of claims 1-24 as comprising non-statutory subject matter under 35 U.S.C. §101 is prima facie defective and should be withdrawn, and claims 1-24 should be allowed.

Response to Rejection under 35 U.S.C. §103(a):

The Office Action states (page 3) that claims 1-38 stand rejected as being unpatentable over Fields et al., U.S. Patent No. 6,128,655 (hereinafter "Fields") in view of Bernardo et al., U.S. Patent No. 6,247,032 B1. Applicant respectfully submits that claims 1-38 are not unpatentable over Fields in view of Bernardo and requests reconsideration.

In traversing the rejection, it is helpful to first briefly review the teachings of the applied references. Such follows hereinbelow.

Fields is directed (Title) to a: "Distribution mechanism for filtering, formatting and reuse of web based content". Fields teaches that "The invention provides an automated system for replicating published web content and associated advertisements in the context of a hosting web site. At the hosting web site, the invention includes the process of brokering a client browser's request for a web page, analyzing the returned content and splitting it into component elements, extracting the desired component elements, recasting the desired elements in the look and feel of the hosting site and sending the recast content to the requesting client as a web page. Once the reformatted file is received at the client, the client browser interprets the HTML in the web page, presenting the content in the context of the hosting web site. On the content provider's web site, the details of the transaction in the web server logs are preserved, proxying a direct page view and ad impression. " (Abstract).

Bernardo is directed (Title) to an: "Automated system and method for approving web site content". Bernardo describes "A software tool is provided for use with a computer system for simplifying the creation of Web sites. The tool

comprises a plurality of pre-stored templates, comprising HTML formatting code, text, fields and formulas. The templates preferably correspond to different types of Web pages and other features commonly found on or available to Web sites. Each feature may have various options. To create a web site, a Web site creator (the person using the tool to create a web site) is prompted by the tool through a series of views stored in the tool to select the features and options desired for the Web site. Based on these selections, the tool prompts the web site creator to supply data to populate fields of the templates determined by the tool to correspond to the selected features and options. Based on the identified templates and supplied data, the tool generates the customized Web site without the web site creator writing any HTML or other programming code. Automated routing for site approval to authorized approvers specified during creation of the web site is provided." (Abstract).

In contrast, claim 1 recites "A method comprising: retrieving content from a plurality of content providers, wherein the retrieved content is to be displayed in at least one Web page; verifying the format of the retrieved content; rejecting particular content if the particular content format is not valid; and if the particular content is valid: scheduling the particular content to be displayed at a specified time; and displaying the particular content at the specified time, the particular content being displayed by a Web server", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

The Office Action states (p. 3) that: "Fields teaches Fields teaches enacting a 'filter policy' (i.e., a schema file) for a particular Web content provider's

submission format for parsing specific content (i.e., validating licensing, accepting specific ads, etc.) (Fields column 10 lines 23-37), therefore the retrieved format of the content is verified (compare with claim 1 *"verifying the format of the retrieved content"*)". Applicant disagrees.

Fields teaches use of filters (col. 9, line 38 et seq.; Figs. 6A and 6B) for accepting or rejection *portions* of content in accordance with a set of rules or policies. Note boxes 523 in Fig. 6A, which, if "checked", correspond to portions, which, if present in the content, are retained. Such is not the same as verification of the *format* or *structure* of a file, and in fact, such *presupposes* that the format is acceptable. See, e.g., col. 1, lines 9 et seq., stating that:

> The World Wide Web is the Internet's multimedia information retrieval system. In the Web environment, client machines effect transactions to Web servers using the Hypertext Transfer Protocol (HTTP), which is a known application protocol providing users access to files (e.g., text, graphics, images, sound, video, etc.) using a standard page description language known as Hypertext Markup Language (HTML). **HTML provides basic document formatting and allows the developer to specify "links" to other servers and files.** In the Internet paradigm, a network path to a server is identified by a so-called Uniform Resource Locator (URL) having a special syntax for defining a network connection. Use of an HTML-compatible browser (e.g., Netscape Navigator or Microsoft Internet Explorer) at a client machine involves specification of a link via the URL. In response, the client makes a request to the server (sometimes referred to as a "Web site") identified in the link and, in return, **receives in return a document or other object formatted according to HTML**.

Why would Fields teach or disclose "verifying the format of the retrieved content; rejecting particular content if the particular content format is not valid", as recited in claim 1, or "a content verification tool coupled to the content collector, the content verification tool configured to verify content retrieved from the plurality of content providers", as recited in claim 25, or "verify the format of the

retrieved content", as recited in claim 34, when Fields teaches use of a single, predetermined format? As such, Fields fails to provide the elements that are affirmatively recited in claims 1 and 25.

Because Fields does not teach, disclose, suggest or motivate verification of format, it is inconceivable that Fields could provide "rejecting particular content if the particular content format is not valid", as recited in claim 1, or "reject the retrieved content if the format of the retrieved content is not valid", as recited in claim 34.

In fact, Fields teaches away from multiple formats, stating (col. 2, line 16 et seq., that:

> **It is unlikely that a web content provider** who is essentially sharing his content for free **will be willing to** install special software or **specially format his information for the hosting site**. If the material comes in raw format, considerable manpower must thus be devoted to making borrowed material on the hosting site look as though it was specifically created for the site. This effort is naturally compounded where material comes from a range of web content providers. Further, there is likely to be some lag between the time that the web content is available on the content provider's web page and its appearance on the hosting site. This dilutes the desired appearance of the hosting site having the latest and greatest material.

As such, there is no need in the system taught by Fields to verify the format of content. Put another way, it is improper to combine references when the references teach away from the proposed combination. This is explained below in more detail with reference to MPEP §2145, entitled "Consideration of Applicant's Rebuttal Arguments".

In a subsection (X)(D)(2), entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination", this MPEP section states that: "It is improper to combine references where the references teach away

from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)". Accordingly, the combination of references proposed in the Office Action is improper.

The Office Action states (p. 4) that "Bernardo teaches a Web site page content approval process, whereby said pages are sent to a designated user for approval pending publication, said approval subject to time limits (i.e. a timeslice comprising beginning and end times)(Bernardo Abstract, column 10 lines 54-58, column 11 lines 1-5; compare with claim 1 *"scheduling"* and *"at a specified time"*). Applicant disagrees for several reasons.

First, paraphrasing Applicant's claim by elision of affirmatively-recited subject matter fails to provide or even consider Applicant's claimed subject matter. The Office Action has failed to identify at least the following **bolded** portions of the subject matter of claim 1: "**displaying** the particular content **at the specified time**, the particular content being displayed **by a Web server**". Clarification of the rejection is requested.

Second, Bernardo is not scheduling anything for display by a Web server; Bernardo is merely eliminating delay by setting time limits for an approval process. If the reviewer does not review the material within the specified time slice, (i) the material may well not have been displayed at all and (ii) it has not been displayed by a Web server. As such, Bernardo fails to provide the elements for which Bernardo is cited.

For at least these reasons, the rejection of claims 1, 25 and 34 is improper and should be withdrawn, and claims 1, 25 and 34 should be allowed.

Claim 12 recites "A method comprising: identifying a plurality of content providers; determining whether each of the plurality of content providers has any new content to retrieve; retrieving new content from the plurality of content providers that have new content to retrieve; storing the retrieved content in a central database; scheduling the retrieved content to be displayed on a Web page at a particular time, wherein the particular time is based on an attribute associated with the retrieved content; and displaying the retrieved content on the Web page at the particular time", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, the proposed combination fails to provide anything relative to "scheduling the retrieved content to be displayed on a Web page at a particular time", as recited in claim 12. Further, the Office Action admits, **on the record** (p. 5), that neither reference nor the proposed combination provides "storing the retrieved content in a central database", as affirmatively recited in claim 12. Neither the references nor the Office Action mention "determining whether each of the plurality of content providers has any new content to retrieve" or "retrieving new content from the plurality of content providers that have new content to retrieve", as recited in claim 12.

Claim 20 recites "A method comprising: identifying a plurality of content providers; identifying a storage location associated with each of the content providers; retrieving a file from each storage location, wherein the file identifies any new content to retrieve from the storage location; if the file identifies new content to retrieve from the storage location: retrieving the new content; storing the retrieved content in a central database; and scheduling the retrieved content to

be displayed at a particular time, wherein the particular time is based on an attribute associated with the retrieved content", which is not taught, disclosed, suggested or motivated by the cited references.

The Office Action states (p. 6) that Claim 20 incorporates substantially similar subject matter as claimed in claim 1. Applicant disagrees. Claim 20 recites numerous aspects of the claimed subject matter not found in claim 1.

The Office Action fails to identify where either of the references might even touch on "identifying a storage location associated with each of the content providers", or "retrieving a file from each storage location, wherein the file identifies any **new content** to retrieve from the storage location", or "if the file identifies new content to retrieve from the storage location: retrieving the new content; storing the retrieved content in a central database; and scheduling the retrieved content to be displayed at a particular time" or, for that matter, doing so "wherein the particular time is based on an attribute associated with the retrieved content". The filter database taught by Fields does not overcome these deficiencies.

Claim 31 recites "A content processing system comprising: a content server configured to retrieve Web-based content from a plurality of Web content providers, wherein the content is defined in an extensible markup language (XML) file; a database coupled to the content server, the database configured to store content retrieved from the plurality of content providers; and a Web server coupled to the content server, the Web server including a schema file that defines the proper format for the content, wherein the Web server is configured to maintain a plurality of Web pages that are generated using content stored in the

database", which is not taught, disclosed, suggested or motivated by the cited references.

Fields is silent regarding any database for storage of content defined by XML files. Fields is similarly silent regarding any schema files that define proper content for content to be displayed. The Office Action fails to show where such might be found in the references.

All of the rejections based on combinations of elements taken from the references fail to meet the standards for a finding of unpatentability set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), §2141 et seq. and §2142). Further, simply providing a conclusory statement that "It would have been obvious ...." fails to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), §2141 et seq. and §2142).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims, as noted with specificity hereinabove. Accordingly, the references cannot possibly provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no

such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, as noted with specificity hereinabove, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim. As such, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Arguendo, even if the references could be combined, the resultant combination would not be obvious because the prior art does not suggest the desirability of the combination due to their contextual disparity, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), as discussed in MPEP §2143.01.

Further, the Office Action identifies no teaching whatsoever in the references of the subject matter recited in these claims. Additionally, there is no teaching or disclosure, or guidance, suggestion or motivation identified in the references or by the Office Action to attempt to combine or modify, or to aid one

of ordinary skill in picking and choosing elements from the diverse embodiments of the references or in assembling those elements to attempt to arrive at the subject matter of any of Applicant's claims. As such, the rejection appears to employ an inappropriate 'obvious to try' standard of unpatentability.

Such is improper, as is discussed below in more detail with reference to MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted)".

In this instance, no guidance in selecting some but not others of the many elements from the many embodiments of the references is identified. Similarly, no direction as to which of many possible choices is likely to be successful has been identified.

As there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to

construct a reason for combining and/or modifying the teachings of the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

Additionally, no **evidence** has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

For at least these reasons, the rejection of claims 1-38 is improper and should be withdrawn, and claims 1-38 should be allowed.

Conclusion

Claims 1-38 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Sept. 16, 2004

By: _____

Frederick M. Fliegel
Reg. No. 36,138
(509) 324-9256 x239

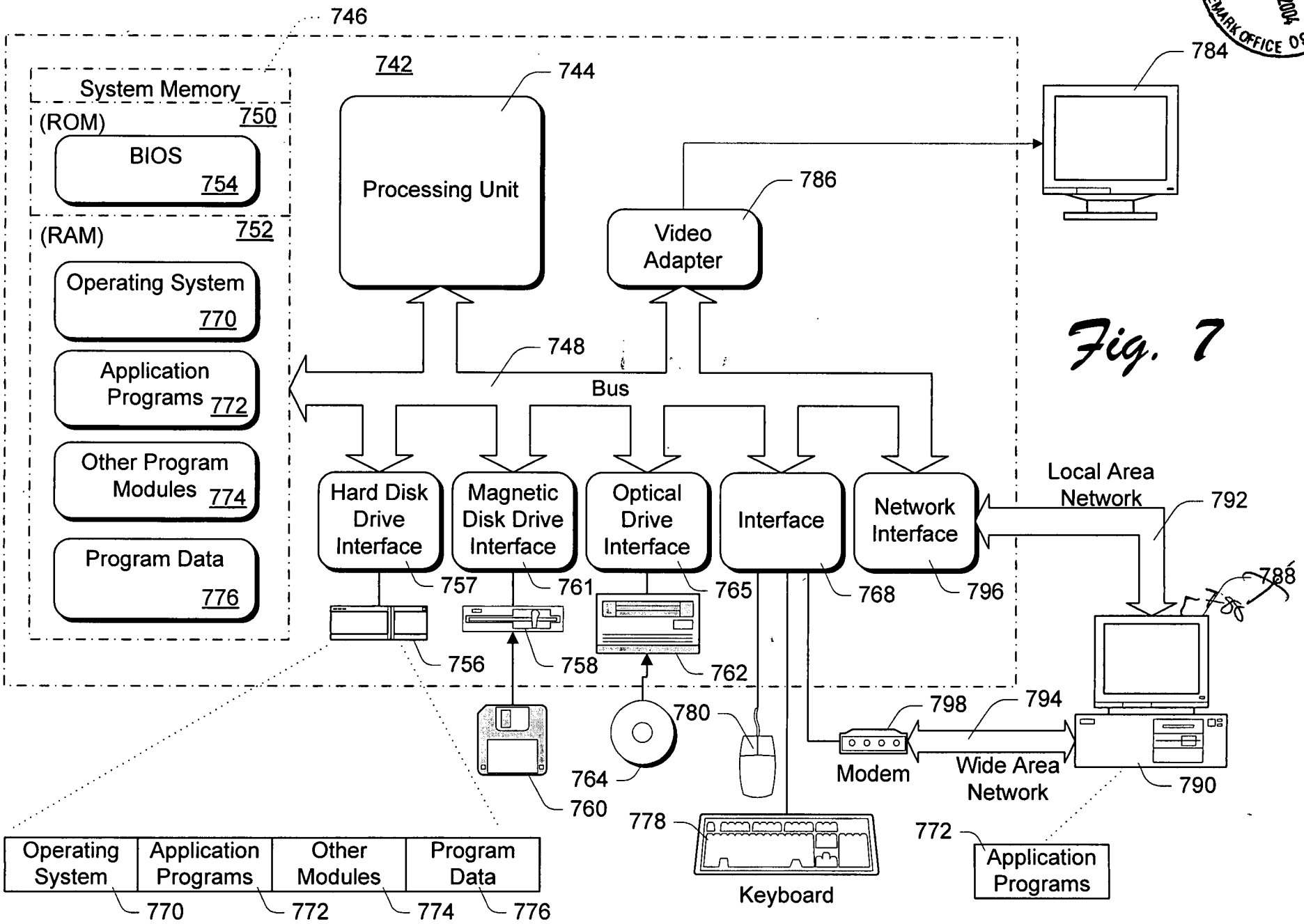

Fig. 7

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